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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,163	06/16/1999	BRUCE NAGEL	MPS-411XC1	5018
23557	7590	02/17/2004	EXAMINER	
SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION 2421 N.W. 41ST STREET SUITE A-1 GAINESVILLE, FL 326066669			COLLINS, CYNTHIA E	
			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 02/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/334,163

Applicant(s)

NAGEL, BRUCE

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10, 11, 16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 10-11, 16, 18-22 and 24-25 is/are allowed.
- 6) ☒ Claim(s) 23, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2003 has been entered.

Claims 1, 6, 16 and 23 are currently amended.

Claims 7-9, 12-15 and 17 are cancelled.

Claims 1-6, 10-11, 16 and 18-27 are pending and are examined.

All previous objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 112

Claims 23, 26 and 27 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for the reasons of record set forth in the office action mailed June 17, 2003.

Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

Applicant asserts that the prior action improperly implies that an actual reduction to practice is required prior to filing to meet the written description requirement. Applicant argues that the correct standard is whether one skilled in the art would understand applicant to be in possession of what is claimed, and that by obtaining a true-breeding line the inventor is

Art Unit: 1638

effectively in possession of F1 offspring by virtue of existing corn varieties that are publicly available for breeding purposes. Applicant additionally disagrees that it would not be possible to determine whether a plant of unknown parentage is covered by the claims because the ordinary artisan could readily determine by routine molecular characterization whether an F1 hybrid has as one of its parents a plant according to claim 6 (reply page 5).

It is maintained that the prior action imposed no requirement for an actual reduction to practice prior to filing to meet the written description requirement. The prior action merely raised the issue that neither the phenotypic nor the genotypic characteristics of the claimed F1 hybrid seed and plants had been described in the specification. It is additionally maintained that mere possession of the claimed invention is not necessarily sufficient to satisfy the written description requirement, as the specification must also describe the invention in a manner that allows one skilled in art to recognize what is claimed. In the instant case Applicant has not described what is claimed. Applicant has not described any particular phenotypic or genotypic characteristic(s) of any F1 offspring obtained by crossing a corn plant according to claim 6 with another different corn plant. Applicant has not described the characteristic(s) of a corn plant according to claim 6 that would be exhibited by the claimed F1 hybrid seed and plants. Furthermore, the assertion that the ordinary artisan could readily determine by routine molecular characterization whether an F1 hybrid has as one of its parents a plant according to claim 6 cannot be evaluated and does not support the description of the invention, as the specification does not disclose or describe any molecular characterization of a plant according to claim 6, or of an F1 hybrid that has as one of its parents a plant according to claim 6.

Claim 23 remains rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps, for the reasons of record set forth in the office action mailed June 17, 2003.

Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

Applicant argues that the rejection has been obviated by virtue of the amendment of the claims (reply page 5).

The rejection is maintained because claim 23 as amended still fails to recite the essential steps that would be required to initiate a corn breeding program for developing a corn plant using breeding techniques.

Claim Rejections - 35 USC § 102/103

Claims 26 and 27 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stelpflug et al. (U.S. Patent No. 5,569,820, issued October 29, 1996), for the reasons of record set forth in the office action mailed June 17, 2003.

Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

Applicant argues that the rejection has been obviated because the plants according to claim 6 did not exist until this invention, and because the ordinary artisan could readily determine by routine molecular characterization whether an F1 hybrid has as one of its parents a plant according to claim 6 (reply page 6).

Art Unit: 1638

The rejection is maintained because neither the claims nor the specification set forth any characteristics that would distinguish the claimed F1 hybrid seed and plants from other corn F1 hybrid seed and plants. Furthermore, the specification does not disclose or describe any molecular characterization of any F1 hybrid having as one of its parents a plant according to claim 6.

Remarks

Claims 1-6, 10-11, 16, 18-22 and 24-25 are allowed.

Claims 23, 26 and 27 are rejected.

Claim 23 is deemed free of the prior art due to the failure of the prior art to teach or suggest a corn plant belonging to a corn line selected from the group consisting of LS0417 (ATCC Accession No. PTA-1397), LS1498 (ATCC Accession No. PTA-1396), and LS288 (ATCC Accession No. PTA-3642).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1638

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CC
February 5, 2004

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the printed name and title.